

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,

Petitioner,

v.

NUVASIVE, INC.,

Patent Owner.

Case IPR2013-00506, 00507 and 00508
Patent 8,361,156

Held: November 18, 2014

Before SALLY C. MEDLEY, LORA M. GREEN, and STEPHEN C. SIU, *Administrative Patent Judges*.

The above-entitled matter came on for hearing on Tuesday, November 18, 2014, commencing at 1:15 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

IPR2013-00506, 00507 and 00508
Patent 8,361,156

APPEARANCES:

ON BEHALF OF THE PETITIONER:

JEFF E. SCHWARTZ, ESQ.
SETH A. KRAMER, ESQ.
MICHAEL COOPERBURG, ESQ.
Fox Rothschild LLP
The Executive Building
1030 15th Street, N.W., Suite 380 East
Washington, D.C. 20005

and

RODNEY M. YOUNG, ESQ.
CHAD A. HANSON, Ph.D., ESQ.
JASON O. PICHE, ESQ.
Medtronic, Inc.
2600 Sofamor Danek Drive
Memphis, Tennessee 38132

ON BEHALF OF PATENT OWNER:

MICHAEL A. AMON, ESQ.
STEPHEN R. SCHAEFER, ESQ.
STUART NELSON, ESQ.
Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130

and

JONATHAN SPANGLER, ESQ.
NuVasive, Inc.
7475 Lusk Boulevard
San Diego, California 92121

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

P R O C E E D I N G S

- - - - -

JUDGE MEDLEY: Good afternoon. This is the hearing for IPRs 2013-00506, 507 and 508 between Petitioner Medtronic and Patent Owner NuVasive. Per the October 20th order that you received from the Board, each party will have 90 minutes of total time to present arguments for the three cases.

Petitioner, you'll proceed first, to present your case with respect to the challenged claims and grounds for which the Board instituted trial for all three cases. And thereafter, Patent Owner, you will respond and use up all of your allotted time, and then, Petitioner, you may reserve rebuttal time if you wish.

At this time we would like the parties to please introduce themselves, beginning with Petitioner.

MR. SCHWARTZ: Yes, Your Honor, my name is Jeff Schwartz, I am joined by Seth Kramer, Mike Cooperberg and Medtronic representatives Rodney Young, Jason Piche and Chad Hanson.

JUDGE MEDLEY: Okay, thank you. And for Patent Owner?

MR. SCHAEFER: Your Honor, I'm Steve Schaefer, lead counsel for Patent Owner NuVasive, and with me is Michael Amon, he's *pro hac vice*, representing NuVasive.

JUDGE MEDLEY: Okay.

1 MR. SCHAEFER: And Stewart Nelson, who is also a
2 back-up counsel. And with me is Jonathan Spangler, in-house counsel
3 for NuVasive.

4 JUDGE MEDLEY: Okay, great. And we did look over
5 the issues. Ninety minutes, we think, per side, seems a bit excessive,
6 if you will. So feel free to shave down anything . You know, an hour
7 per side would be great with us. We don't feel that we need much
8 more than that from the parties, but having said that, we did tell you
9 you had 90 minutes, so if you're prepared for that, that's fine, we just
10 want to throw that out. It won't hurt you to go less than 90 minutes. It
11 might even help.

12 **(Laughter.)**

13 JUDGE MEDLEY: So, with that in mind, Petitioner,
14 you may begin.

15 MR. SCHAEFER: Thank you, Your Honor, and may it
16 please the Board, we realize that this specific panel has heard from
17 both of these parties twice before on this technology, which is spinal
18 fusion implants and procedures, so I'm going to avoid repeating that
19 tutorial that you've already heard and are aware of, and try to focus,
20 instead, on specifically what these claims are about. The nuance
21 being that we're starting from a different time period. We're starting
22 from eight years in the future, in these prior IPRs that you heard
23 between the parties, we were looking at mid-1990s for when those
24 applications had been filed, and now we're looking at 2002-2003 for
25 when these applications were filed.

1 The key difference there is that we're able to rely on the
2 patents that you were looking at in those other IPRs as prior art to
3 NuVasive's patents, and so that's a key difference between the
4 arguments that you heard before. And going into it, my intention is to
5 just summarize what the initial claims are about, talk about the prior
6 art, and then get right into what the grounds are and what the art
7 shows.

8 So, if we can have claim 1 of the '156 patent, this patent
9 pertains specifically to the 506 IPR, and in general, what claim 1 is
10 describing is a spinal fusion implant, a device, it generally requires
11 antimigration elements on the top and bottom. It has an aperture, as
12 you can see, that's generally elongated, so its length is greater than its
13 width. It has -- it's made up of radiolucent material, and so therefore
14 the claim requires some markers so that you can see where the implant
15 is once you've implanted it.

16 This particular claim requires two markers in the center
17 of the implant. So, if you want to see where the middle is once you
18 put it in the patient, you can see by putting two markers in the middle.

19 Additionally, it's elongated, so the length is greater than
20 the width. And the maximum width is on the medial plane, or in the
21 middle of that implant.

22 If you could put claim 1 of the '334 patent up. The '334
23 patent is the subject of both the 507 and the 508 IPRs. This is a claim
24 that's very similar to what you just saw with the '156 patent, so I'll just
25 talk about the differences.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.